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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/742,047	12/20/2000	Steve Okun	11271STUS01U	9953
7590 Garlick & Harrison P.O. Box 670007 Dallas, TX 75367			EXAMINER MILLER, BRANDON J	
			ART UNIT	PAPER NUMBER
			2617	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/01/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/742,047

Applicant(s)

OKUN ET AL.

Examiner

Brandon J. Miller

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response

Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 25 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cannon et al. (US 6,393,272 B1) in view of Crockett et al. (US 6,633,634 B1) and Forlenza et al. (6,665,375 B1).

Regarding claim 25 Cannon teaches a mobile station comprising: communication circuitry for processing wireless communication signals (see col. 2, lines 11-19). Cannon teaches audio processing circuitry for converting between sound and audio signal and for receiving sound from a microphone and for producing sound to a speaker (see col. 3, lines 11-19 and col. 4, lines 32-36 & 64-67). Cannon teaches logic to prompt the mobile station to generate signaling to a communication network element to complete call setup including completing connection of a voice channel and further to mute the microphone even though an incoming call is connected (see col. 2, lines 21-29 & 51-65). Cannon teaches logic circuitry for prompting the mobile station to transmit a request to play a specified message to the calling party to advise the calling party that it is being placed on hold and that the called party will be taking the call shortly

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(see col. 2, lines 33-40). Cannon teaches wherein the mobile station only transmits the request if the called party depressed a select button or key while being alerted that a call was coming in for the called party (see col. 2, lines 30-40). Cannon does not specifically teach prompting a called party to take the call after a specified period of time as a reminder that a calling party is on hold. Crocket teaches prompting a called party to take the call after a specified period of time as a reminder that a calling party is on hold (see col. 6, lines 30-34 & 47-52). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the device in Cannon adapt to include Crocket's prompting a called party to take the call after a specified period of time as a reminder that a calling party is on hold because a reminder can be generated while the voice channel is connected (see Crocket, col. 6, lines 45-51) and it would allow for improved call waiting service features.

Cannon and Crocket do not specifically mention transmitting a request to a mobile switching center to further prompt an interactive voice response system to play a message. Forlenza further modifies the combination of Cannon and Crocket by teaching an interactive voice response system that plays a message (see col. 1, lines 45-51). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the device in Cannon and Crocket adapt to include transmitting a request to a mobile switching center to further prompt an interactive voice response system to play a message because an interactive voice response system can provide messages to a calling party and the combination would allow for improved indication of call connection status.

Regarding claim 27 Cannon teaches a select button that is a keypad number button (see col. 2, lines 29-31).

Claims 28-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cannon et al. (US 6,393,272 B1) in view of Crockett et al. (US 6,633,634 B1).

Regarding claim 28 Cannon teaches a mobile station comprising: communication circuitry for processing wireless communication signals (see col. 2, lines 11-19). Cannon teaches audio processing circuitry for converting between sound and audio signal and for receiving sound from a microphone and for producing sound to a speaker (see col. 3, lines 11-19 and col. 4, lines 32-36 & 64-67). Cannon teaches logic circuitry for prompting the mobile station to complete call connection including the voice channel and further to mute the microphone until the called party takes the call to prevent audio transmission over the connection call until the called party takes the call (see col. 2, lines 21-29 & 51-65). Cannon teaches transmitting a message to the calling party to advise the calling party that the called party will be taking the call shortly (see col. 2, lines 33-40). Cannon does not specifically mention prompting a called party to take the call after a specified period of time has elapsed as a reminder that a calling party is on hold. Crockett teaches completing connection of a voice channel (see col. 4, lines 15-19 and col. 5, lines 55-58). Crockett teaches prompting a called party to take the call after a specified period of time has elapsed as a reminder that a calling party is on hold (see col. 6, lines 30-34 & 47-52). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the device adapt to include prompting a called party to take the call after a specified period of time has elapsed as a reminder that a calling party is on hold

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because a reminder can be generated while the voice channel is connected and this would allow for improved indication of call connection status.

Regarding claim 29 Cannon teaches a mobile station wherein the message is only transmitted if the called party depressed a select button or key while being alerted that a call was coming in for the called party (see col. 4, lines 3-14).

Regarding claim 30 Cannon teaches a microphone that is muted until the called party depresses a select key indicating that he is ready to take the call (see col.2, lines 51-65).

Regarding claim 31 Cannon teaches a speaker that is muted until the called party depresses a select key indicating that he is ready to take the call (see col.2, lines 51-65).

Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chow et al. (US 6,606,505 B1) in view of Forlenza et al. (6,665,375 B1).

Regarding claim 32 Chow teaches a method for connecting a call placed by a calling party to a called party having a multi-line capable phone (see col. 7, lines 21-26 and col. 72, lines 11-24). Chow teaches receiving an indication that a call is to be setup with the called party and determining a service node for the called party and transmitting call setup signals to the serving node (see col. 22, lines 11-13 & 49-67 and col. 23, lines 1-3). Chow teaches receiving an indication of the called party number (see col. 5, lines 29-33). Chow teaches connecting a first call to the called party (see col. 7, lines 21-26). Chow teaches receiving an indication from the called party to place the calling party on hold (see col. 73, lines 54-59 and col. 74, lines 35-40). Chow teaches responding to a called party response by triggering the play of a select message to the calling party to advise the calling party that the called party will be taking the call shortly (see col. 34, lines 50-61). Chow teaches when a specified period of time has elapsed, proving on

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behalf of the calling party a reminder to the called party that a call is still waiting (see col. 38, lines 5-9). Chow does not specifically teach an interactive voice response (IVR) to play a specified message. Forlenza teaches using an IVR for specified messages in call holding features (see col. 1, lines 45-51). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the device adapt to include an interactive voice response (IVR) to play a specified message because an interactive voice response system can provide messages to a calling party and this would allow for improved methods of transmitting a signal indicating a call has been placed on hold.

Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cannon et al. (US 6,393,272 B1) in view of Crockett et al. (US 6,633,634 B1), Forlenza et al. (6,665,375 B1), and Chow et al. (US 6,606,505 B1).

Regarding claim 26 Cannon, Crockett, and Forlenza teach a device as recited in claim 25 except for prompting the mobile station to transmit an indication that the called party is ready to take the call. Cannon does teach a user of a mobile station that decides to take a call on hold by terminating the hold-state (see col. 3, lines 65-67). Chow teaches prompting the mobile station to transmit an indication that the called party is ready to take the call (see col. 42, lines 53-56). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the device adapt to include prompting the mobile station to transmit an indication that the called party is ready to take the call because this would allow for efficient and effective processing of call waiting features.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 25 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The term "a calling party" is recited in line 1 and line 9 of the claim and it is unclear as to whether there are one or two calling parties in the claim.

Claim 28 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The term "a calling party" is recited in line 1 and line 6 of the claim and it is unclear as to whether there are one or two calling parties in the claim.

Claim 32 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The term "a called party" is recited in line 1 and line 9 of the claim and it is unclear as to whether there are one or two called parties in the claim.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 25, 28, and 32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 25 recites the limitation "the calling party" in lines 11 and 12. There is insufficient antecedent basis for this limitation in the claim.

Claim 28 recites the limitation "the calling party" in lines 9 and 10. There is insufficient antecedent basis for this limitation in the claim.

Claim 32 recites the limitation "the called party" in lines 10 and 12. There is insufficient antecedent basis for this limitation in the claim.

The above art rejection is based on the best possible interpretation of the ambiguous claim language described in the rejection under 35 U.S.C. 112, first and second paragraphs.

Response to Arguments

Applicant's arguments with respect to claims 25-32 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Gutzmann U.S Patent No. 6,118,861 discloses a calling party invoked held call monitoring.

Nakamura U.S Patent No. 6,553,221 discloses incoming call notification apparatus.

Nguyen U.S. Patent No. 5,995,848 discloses a system and method of completing calls to busy mobile subscribers in a radio telecommunications network.

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Ahlberg U.S. Patent No. 5,657,372 discloses systems and methods for selectively accepting telephone calls without establishing voice communications.


Burg U.S. Patent No. 6,219,413 B1 discloses an apparatus and method for called-party telephone messaging while interconnected to a data network.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brandon J. Miller whose telephone number is 571-272-7869. The examiner can normally be reached on Mon.-Fri. 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on 571-272-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


January 24, 2007


GEORGE ENG
SUPERVISORY PATENT EXAMINER